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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/647,044	08/22/2003	Benjamin Neiger	0931CON	1680
31108	7590	10/19/2005	EXAMINER	
PAUL J. SUTTON, ESQ., BARRY G. MAGIDOFF, ESQ. GREENBERG TRAURIG, LLP 200 PARK AVENUE NEW YORK, NY 10166			HOANG, ANN THI	
			ART UNIT	PAPER NUMBER
			2836	

DATE MAILED: 10/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/647,044

Applicant(s)

NEIGER ET AL.

Examiner

Ann T. Hoang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Specification

1. The disclosure is objected to because of the following informalities: On page 7, line 1, "Figure 4" should be changed to "Figure 5." On page 7, line 14, the third blocking capacitor 65 should be numerically referenced with the number 56 instead, in order to be consistent with the drawings.

Appropriate correction is required.

Double Patenting

2. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

3. Claims 3 and 5 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 2 and 3, respectively, of prior U.S. Patent No. 5,729,417. This is a double patenting rejection. Claims 3 and 5 of the application are duplicates of claims 2 and 3 of the patent.

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent

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and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1, 2 and 4 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2 and 3, respectively, of U.S. Patent No. 6,611,406 in view of Bienwald et al. (US 4,568,997).

Regarding claim 1 of the application, claim 1 of the patent recites a ground fault circuit interrupter comprising: ground fault current interrupter means electrically connected between a source of electrical power and a load for interrupting the flow of electrical current from said source of electrical power to said load when a ground fault condition exists; and indicating means responsive to said ground fault current interrupter means for automatically indicating when said ground fault current interrupter means is not properly electrically connected to said source of electrical power. Claim 1 of the patent also recites the ground fault current interrupter means to have a test button that trips and shuts off power when pushed to verify operation of the internal functions of the ground fault current interrupter. Additionally, claim 1 of the patent adds the limitations of the indicating means to include a light generating device coupled to receive electrical power to and from the ground fault current interrupter means and to automatically indicate the improper electrical connection by illuminating the light generating device.

Claim 1 of the application does not claim the test button or the light generating device as the light indicating means. Use of a light generating device as an indicating means is obvious and expedient in the art.

Furthermore, Bienwald et al. discloses a ground fault circuit interrupter having a test button 71 that trips and shuts off power when pushed to verify operation of the internal functions of the ground fault current interrupter. See column 4, lines 43-55 and column 5, lines 58-61. Bienwald et al. also discloses a light generating device 81 coupled to receive electrical power to and from the ground fault circuit interrupter means that illuminates when the ground fault circuit interrupter means is not properly electrically connected to the source of electrical power. See column 5, lines 1-5. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the test button and the light generating device of Bienwald et al. with the ground fault circuit interrupter of the patent in order to provide a means for checking the operation of the ground fault circuit interrupter, e.g. ensuring that it is not defective, and to provide a visual indication of improper installation to the user.

Regarding claim 2 of the application, claim 2 of the patent recites a ground fault circuit interrupter comprising: ground fault current interrupter means electrically connected between a source of electrical power and a load for interrupting the flow of electrical current from said source of electrical power to said load when a ground fault condition exists; said ground fault current interrupter means including receptacle means for coupling said source of electrical power to an external electrical device; and indicating means responsive to said ground fault current interrupter means for

automatically indicating when said ground fault current interrupter means is not properly electrically connected to said source of electrical power thereby alerting a user that the flow of electrical current from said source of electrical power to said external electrical device will not be interrupted when a ground fault condition exists. Claim 2 of the patent also contains the same additional limitations as that of claim 1 of the patent as applied to claim 1 of the application. Therefore, claim 2 of the application is rejected under the same reasoning as that of claim 1 of the application. See above rejection.

Regarding claim 4 of the application, claim 3 of the patent recites a ground fault circuit interrupter electrically connected between a source of electrical power and a load and which interrupts the flow of electrical current from said source of electrical power to said load when a ground fault condition exists, wherein the improvement comprises: indicating means electrically connected to said ground fault current interrupter means for automatically indicating when said ground fault current interrupter means is not properly electrically connected to said source of electrical power. The ground fault current interrupter means of claim 3 of the patent is interpreted to be the same element as the ground fault circuit interrupter, therefore claim 3 of the patent contains all the elements recited in claim 4 of the application. Claim 3 of the patent also contains the same additional limitations as that of claim 1 of the patent as applied to claim 1 of the application. Therefore, claim 4 of the application is rejected under the same reasoning as that of claim 1 of the application. See above rejection.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1, 2, and 4 rejected under 35 U.S.C. 102(b) as being anticipated by Bienwald et al. (US 4,568,997).

Regarding claim 1, Bienwald et al. teaches a ground fault circuit interrupter comprising: ground fault current interrupter means electrically connected between a source of electrical power (at terminals 1 and 3) and a load (at terminals 21 and 23) for interrupting the flow of electrical current from said source of electrical power to said load when a ground fault condition exists; and indicating means 81 responsive to said ground fault current interrupter means for automatically indicating when said ground fault current interrupter means is not properly electrically connected to said source of electrical power. See abstract; Fig. 1; column 3, lines 35-40 and 53-54; column 4, lines 43-55 and column 5, lines 1-5 and 58-61.

Regarding claim 2, Bienwald et al. teaches a ground fault circuit interrupter comprising: ground fault current interrupter means electrically connected between a source of electrical power (at terminals 1 and 3) and a load (at terminals 21 and 23) for interrupting the flow of electrical current from said source of electrical power to said load when a ground fault condition exists; said ground fault current interrupter means including receptacle means for coupling said source of electrical power to an external

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electrical device; and indicating means 81 responsive to said ground fault current interrupter means for automatically indicating when said ground fault current interrupter means is not properly electrically connected to said source of electrical power thereby alerting a user that the flow of electrical current from said source of electrical power to said external electrical device will not be interrupted when a ground fault condition exists. See abstract; Figs. 1-2, column 3, lines 35-40 and 53-54; column 4, lines 43-55; column 5, lines 1-27 and 53-61; and column 6, lines 61-62.

Regarding claim 4, Bienwald et al. teaches a ground fault circuit interrupter electrically connected between a source of electrical power (at terminals 1 and 3) and a load (at terminals 21 and 23) and which interrupts the flow of electrical current from said source of electrical power to said load when a ground fault condition exists, wherein the improvement comprises: indicating means 81 electrically connected to said ground fault circuit interrupter for automatically indicating when said ground fault circuit interrupter is not properly electrically connected to said source of electrical power. See abstract; Fig. 1; column 3, lines 35-40 and 53-54; column 4, lines 43-55 and column 5, lines 1-5 and 58-61.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ann T. Hoang, whose telephone number is 571-272-2724. The examiner can normally be reached Mondays through Fridays, 8:00 a.m. to 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Sircus, can be reached at 571-272-2058. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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